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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,072	05/10/2005	Andreas Van Eikeren	H01.2-11733	8652

490 7590 01/17/2007
VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

LEWIS, RALPH A

ART UNIT	PAPER NUMBER
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3732

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary

Application No.

10/517,072

Applicant(s)

EIKEREN ET AL.

Examiner

Ralph A. Lewis

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Objection to New Matter in Drawings

The proposed drawing filed October 17, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention.

The newly proposed Figure 1 introduces new matter into the specification that was not present when originally filed. More particularly, there is absolutely no support for the particular structure illustrated – e.g. the circular cross section of the plunger stems, the parallel arrangement of the barrels, the shape of barrels 12 and 14, the proportions between the barrels, plungers and mixing chamber, the coupling structure between the barrels 12, 14 and the mixing chamber 20. There is no support for the proportions illustrated.

Applicant is required to cancel the new matter in the reply to this Office Action.

Rejections based on Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5 and 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Dragan (US 5,676,543).

Dragan discloses an addition reaction silicone (A-silicone) 10 that is applied to and covers a patient's teeth and which cross-links in a self cure manner. The applied material meets the broad limitation of protecting the surrounding gums and teeth from dental treatment means. In regard to the new limitation that the material adheres to the teeth and gingival, it is noted that such adherence is implicit in the Dragan disclosure, otherwise it would be incapable of retracting the gum tissue – it would just fall out the patient's mouth.

Claims 1-3, 5, 9, 10, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Amstutz et al (US 4,559,013).

Amstutz et al disclose a protective addition reaction silicone (column 5, lines 14-15) that is applied to a patient's surrounding teeth and gums where it cross-links and self cures to produce an elastomeric material. The composition is a two-component system that is mixed together (column 5, lines 9 and 10). In regard to the new limitation that the material adheres to the teeth and gingival, it is noted that such adherence is implicit in the Amstutz et al disclosure, otherwise it would be incapable of serving as an orthodontic shield – it would just fall out the patient's mouth.

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Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Drake (US 4,538,920).

Drake discloses a dual plunger syringe with mixing chamber for dispensing two component silicone materials (see column 4, line 65). It is noted that it appears from the claim that applicant is only claiming the syringe device and not the combination of the syringe device and material.

In response to the present rejection applicant appears to assert that the composition is being positively claimed as part of the "device for isolating tooth material." If applicant is indeed trying to claim the combination of the device for isolating and the composition it self, then the claim including its preamble should be amended to clearly reflect such. Applicant's attention is directed to *In re Rohrbacher*, 128 USPQ 117 (CCPA 1960) for guidance in claim drafting

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dragan (US 5,676,543).

Adjusting the ingredients so that the setting times fall within the ranges claimed would have been obvious to one of ordinary skill in the art as a matter of routine in

practicing the Dragan invention. The use of a common prior art double barrel syringe to provide for such storage and mixing would have been obvious to one of ordinary skill in the art.

Claims 6-8, 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amstutz et al (US 4,559,013).

Adjusting the ingredients so that the setting times fall within the ranges claimed would have been obvious to one of ordinary skill in the art as a matter of routine in practicing the Amstutz et al invention. The use of a common prior art double barrel syringe to provide for such storage and mixing would have been obvious to one of ordinary skill in the art.


Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drake (US 4,538,920) in view of Konings et al (US 5,371,162).

To the extent that the present claim requires an A-silicone in combination with the dispensing device, Konings et al is cited as teaching that addition cured silicones are well known in the dental art (note column 1, line 65). To have merely used the Drake silicone dispenser for conventional A-silicones as taught by Konings et al would have been obvious to the ordinarily skilled artisan.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (571) 273-8300. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Cris Rodriguez, can be reached at (571) 272-4964.

R.Lewis
January 8, 2007



Ralph A. Lewis
Primary Examiner
Au3732